

REMARKS

Applicants respectfully request reconsideration of the present application. Upon entry of the above amendment, claims 20-28 remain pending in the present application. Claims 6-10 and 15-19 have been cancelled without prejudice or disclaimer. Applicants reserve the right to pursue these or similar claims by another application.

Rejection of Claims 15-18 Under 35 U.S.C. § 112, second paragraph.

Claims 15-18 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 15-18 have been cancelled herein and, thus, this basis of rejection now is moot and should be withdrawn.

Rejection of Claims 6-9 and 15-19 Under 35 U.S.C. § 103(a).

Claims 6-9 and 15-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 89/07399 in view of U.S. Patent No. 4,273,794 to *von Stering-Krugheim*. Applicants urge that this basis of rejection is now moot in view of the cancellation of these claims herein. Consequently, Applicant requests withdrawal of this basis of rejection.

Rejection of Claims 6-9 and 15-19 Under 35 U.S.C. § 103(a).

Claims 6-9 and 15-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 89/07399 in view of *von Stering-Krugheim* and optionally in further view of *Kerkvliet* (Journal of Agricultural Research, 35 (3/4): 110-117 (1996)). This basis of rejection is now moot in view of the cancellation of these claims herein. Consequently, withdrawal of this basis of rejection is appropriate.

Rejection of Claim 10 Under 35 U.S.C. § 103(a).

Claim 10 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 89/07399 in view of *von Stering-Krugheim*, optionally in further view of *Kerkvliet*, and further view of U.S. Patent No. 5,112,964 to Aoe et al. Applicants urge that this basis of rejection is now moot in view of the cancellation of claim 10 herein and request withdrawal of this rejection.

Rejection of Claims 6-10 and 15-19 Under 35 U.S.C. § 103(a).

Claims 6-10 and 15-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over GB1,571,251 in view of U.S. Patent No. 5,612,074 to *Leach*. This basis of rejection is now moot in view of the cancellation of these claims herein. Consequently, withdrawal of this basis of rejection is appropriate.

Rejection of Claims 6-10 and 15-19 Under 35 U.S.C. § 103(a).

Claims 6-10 and 15-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over GB1,571,251 in view of *Leach*, optionally in further view of *Kerkvliet*. Again, Applicants urge that this basis of rejection is made moot in view of the cancellation of these claims herein. Withdrawal of this basis of rejection is hereby requested.

New Claims

Claims 20-28 have been added to the present application as set forth above. Applicants urge that these new claims are patentable over the cited references because, among other reasons, none of the cited references, either singly or in combination, teach or suggest a composition containing 20-60% by weight non-denatured honey that has a peroxide activity amount of greater than about 5µg of hydrogen peroxide per gram honey after sixty minutes as measured at a temperature 21°C.

Although *Kerkvliet* previously has been cited in combination with various references in the rejection of the previously pending claims, this reference does not, by itself or in combination with the other cited references, teach or suggest a composition containing denatured honey with a specified peroxide activity level as claimed in the new claims provided herein. Previously, *Kerkvliet* has been cited in support of the proposition that the composition claimed in the previously pending claims teaches, when combined with either WO 89/07399 and *von Stering-Krugheim* or GB1,571,251 and *Leach*, for it has been alleged that *Kerkvliet* teaches the inherent properties of honey. In the Office Action, it is stated that, "[a]lthough the references do not teach the peroxide activity of the honey used, it is deemed obvious to one of ordinary skill in the art that the honey used by WO has the instant properties since *Kerkvliet* teaches the inherent properties of honey and that natural occurring honey has peroxide values."

While *Kerkvliet* does disclose peroxide values for samples of natural honey, it does not teach that natural occurring honey *necessarily* contains peroxide. Fig. 1 of *Kerkvliet* clearly shows that well over 15% of the samples of the naturally occurring honey tested contained no hydrogen peroxide. Furthermore, Fig. 1 of *Kerkvliet* also shows that well over 50% of all the samples tested contained 5 μ g or less of hydrogen peroxide. Therefore, the hydrogen peroxide content claimed in the new claims is not an inherent characteristic of honey, since not all honey contains hydrogen peroxide in that range.

In order for a characteristic to be an inherent aspect of something within the prior art, that thing must *necessarily* exhibit that characteristic. The characteristic cannot be optionally exhibited by that item and still be an inherent characteristic thereof. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result of characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d

1955, 1957 (Fed. Cir. 1993)” M.P.E.P. 2112. “Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999)” M.P.E.P. 2112. “In relying upon the theory of inherency, the examiner must provide a basis and fact and/or technical reasoning to reasonably support that determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art. *Ex parte Levy*, 17 U.S.P.Q.2d 14612, 1464, Bd. Pat. App. & Inter. 1990)” M.P.E.P. 2112. Although the fact that honey may contain hydrogen peroxide is disclosed in *Kerkvliet*, neither it nor any of the other cited references, either singly or in combination, teach or suggest providing a composition containing honey that has a peroxide content in the range specified as set forth in the new claims. Indeed, no mention is made in any of these references of specifying a particular range of peroxide content in honey, much less using such honey in a particular composition. Consequently, the subject matter of the new claims is not taught nor suggested by the cited references and, thus, should be allowed.

CONCLUSION

Upon entry of the above amendment, claims 20-28 remain pending in the present application. It is respectfully submitted that these claims are in condition for allowance and an early notice to such effect is earnestly solicited. If the examiner believes that issues remain unresolved, it is requested that the examiner contact the undersigned counsel for Applicants by telephone in order to expedite resolution and disposal.

Respectfully submitted,



Thomas B. McGurk
Registration No. 44,920
Louis T. Isaf
Reg. No. 29,078
Attorneys for Applicants

WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
Post Office Box 7037
Atlanta, Georgia 30357-0037
(404) 888-7462 (telephone)
(404) 879-2994 (facsimile)

Docket No.: **I071 1010**

ATLANTA 359736v1